

## REMARKS

Claims 1-23 were pending in the application as originally filed. By way of this amendment, the Applicant has amended claims 1, 3, 7-9, 10, 11, 13, and 15-19; has canceled claims 2, 6 and 12 and added new claims 24-26. Therefore, additional claim fees are not needed.

Accordingly, claims 1, 3-5, 7-11, 13-26 are currently pending.

### I. Rejection of Claims under Section 112

Claims 1-11 stand rejected as being rejected under Section 112 as being indefinite for not including a transitional phrase. Claim 1, the sole independent claim in the instant application, has been amended to include the transitional phrase “comprising” in accordance with US patent practice. All of the remaining dependent claims therefrom have also been amended accordingly to make all of the pending claims in this application clear and definite under Section 112.

Applicant submits that the rejection under Section 112 should be withdrawn.

### II. Rejection of Claims under Section 103

#### A. Claims 1-17

The office action states that claims 1-17 are rejected under Section 103 as being unpatentable over the combination of Weber ‘171 and Yoneyama ‘686.

The office states that the combination of U.S. Patent No. 5829171 (Weber et al.) and JP-6147686 (Yoneyama) teaches the elements of claims 1-17. The examiner states the Weber teaches an insole with an etched heater element. However the examiner admits that Weber does not teach metallised fabric. Yoneyama is cited for the teaching of etched metallised fabric. The examiner mistakenly believes that the metal over each of the threads are etched to form the circuit. However, Yoneyama teaches conductive yarn bundles that have a land contact surface to electrically interconnect to contacts and circuitry on the outer surface of the device. A top (or

bottom) conductive film is what is etched to form the circuitry.

The teachings of the combination of Weber and Yoneyama are very different than the claimed invention that has an insole heater element with metal that is encapsulated over the individual threads itself.

To make the distinction between applicant's invention and that of the cited prior art, applicant has amended the claims to call for a metallised substrate of porous fabric that has a plurality of components each encapsulated with metal wherein the metal on the metallised substrate of fabric is photochemically etched to form the breathable insole heater element by selectively etching out metal encapsulated about the plurality of components of the substrate of porous metallised fabric. Since, the limitations of claims 2 and 12 have been incorporated into base claim 1, these dependent claims have been canceled along with claim 16.

Therefore, cited prior art, even assuming that they are combinable under Section 103, fail to teach claim 1, as amended.

Claims 3-11, 13-15 and 17 are dependent claims that depend, either directly or indirectly, on now allowable claim 1. As a result, applicant submits that claims 3-11, 13-15 and 17 are now also allowable over the cited prior art.

B. Claim 18

Claim 18 is dependent on now allowable independent claim 1. As a result, applicant submits that claim 18 is now also allowable over the cited prior art.

C. Claims. 19-23

Claims 19-23 are dependent claims that depend, either directly or indirectly, on now allowable claim 1. As a result, applicant submits that claims 3-11, 13-15 and 17 are now also allowable over the cited prior art.

III. New Claims 24-26

New claims 24-26 that depend from now allowable claim 1 thereby further limiting the scope of claim 1. Therefore, applicant submits that claims 24-26 are also allowable over the cited prior art.

IV. Terminal Disclaimer

The examiner's attention is directed to three closely related applications that are commonly owned and have the same inventorship. These applications include U.S. Serial No. 10/559,024 (Now U.S. Patent No. 7,375,308); U.S. Serial No. 11/746,116 (Now U.S. Patent No. 7,569,795); U.S. Serial No. 10/558,851 (still pending); and U.S. Serial No. 10/559,023 (still pending). Examiner Vinod Patel in Art Unit 3742 is handling the two pending applications where there are outstanding office actions in each. In both of those respective office actions, Examiner Patel requested a terminal disclaimer of commonly owned U.S. Patent No. 7,569,795. Terminal disclaimers in these pending applications are being filed concurrently with this amendment.

To expedite prosecution of the instant application, applicant is also filing a terminal disclaimer in this application concerning this commonly owned U.S. Patent No. 7,569,795.

V. Conclusion

In view of the foregoing, this application is in condition for allowance. Corresponding action is respectfully solicited. The examiner is invited to contact the undersigned should any questions arise.

Serial No. 10558845

PTO is authorized to charge any additional fees incurred as a result of the filing hereof or credit any overpayment to our account #02-0900.

Respectfully submitted,

/david r. josephs/

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